

REMARKS/ARGUMENTS

This Amendment responds to the Non-Final Office Action mailed on July 18, 2003 (Paper No. 17). This Amendment amends claims 54 and 58 to rewrite them in independent form as suggested by the Examiner. No new matter has been added. Upon entry of this amendment, claims 1-58 are pending in this application, with claims 1, 18, 35, 45, 46, 47, 50, and 57 being independent claims.

Information Disclosure Statement

Applicants submitted Information Disclosure Statements (IDSs) on April 12, 2000 (Paper No. 2), and on December 28, 2001. In the response dated May 30, 2003, Applicants provided copies of certain references, as requested by the Examiner. The Examiner is requested to provide Applicants with an initialed copy of the IDSs submitted on April 12, 2000 and December 28, 2001 to indicate that he has reviewed the references cited therein..

Request for Information

In the Office Action dated July 18, 2003, the Examiner requested comments on the inventorship of the present application in relation to the commonly assigned international application WO 01/69933. Applicants note that the inventorship as listed on the international application WO 01/69933 has been determined to be incorrect. Charles Eldering and Thomas Eames, who were initially inadvertently omitted as inventors in the present application, but who were later added (*see* Request to Correct Inventorship dated May 30, 2003), should also be listed as inventors in international application WO 01/69933 referred to by the Examiner. Applicants will seek to correct inventorship, if possible, in the international application, as well as in any

foreign patent offices in which corresponding national stage applications are pending. This international application includes subject matter from three U.S. applications — (i) the instant application; (ii) Serial No. 09/526,100, filed 03/15/2000; and (iii) Serial No. 09/525,488, filed 03/15/2000. (These applications were cited in the IDS filed in the present application on April 12, 2000.) The subject matter in the international application that differs from the subject matter of the present application corresponds to subject matter contained in the other two U.S. applications mentioned above, *i.e.*, serial numbers 09/526,100 and 09/525,488.

The Examiner has requested a marked-up copy of the instant application illustrating the subject matter added because of the intervening Swisher et al. reference (U.S. Patent No. 6,418,149). In light of the amendment to the priority claims of the present application and the information provided above, Applicants respectfully submit that providing a marked-up copy as requested is unnecessary. Applicants note that Figures 1-2 of the Swisher et al. reference and corresponding text (col. 4, line 1-col. 6, line 22) provided background information which was initially taught in the Eames et al. applications (Serial No. 09/026,036, now U.S. Patent No. 6,317,884), to which the present application now claims priority. Figures 3-5 of the Swisher et al. reference, and corresponding text (col. 5, line 23- col. 9, line 59), illustrate systems and methods for using existing wiring with a residential gateway depict the subject matter added by the Swisher et al. application.

Double Patenting

The Examiner has provisionally rejected claims 1, 20, and 45 under the judicially created doctrine of obviousness-type double patenting as obvious over claims 1, 9, and 30 of co-pending Application No. 09/526,100. The Examiner also provisionally rejected claims 18 and 35

under the judicially created doctrine of obviousness-type double patenting as obvious over claims 16 and 31 of co-pending Application No. 09/488,275. Without admitting to the propriety of these rejections, Applicants note that they will file terminal disclaimers as necessary should the cited co-pending applications be in condition for allowance if and when the instant application is also in condition for allowance.

Rejections Under 35 U.S.C. § 102

The Examiner has rejected claims 1, 3-7, 13-14, 18, 20-24, 31, 35, 37-43, and 45-47 as being anticipated by U.S. Patent No. 6,286,142 to Ehreth ("Ehreth"). The Applicants respectfully disagree with these rejections and request the Examiner to reconsider them.

Specifically, with respect to claim 1, Ehreth does not disclose or suggest, for example, "processing the video signal to produce at least one television signal corresponding to the at least one channel select command" and "transmitting the television signal to the at least one television." Instead, Ehreth discloses producing the at least one television signal within communication controller 30 and transmitting the signal to channel selection and signaling unit 50, which then transmits the signal to a television 100. In addition, Ehreth does not disclose or suggest a residential gateway wherein "at least a first one of [a] plurality of remote control devices transmits [a] channel select command directly to a receiver within the residential gateway," as recited in claim 1.

Claims 3-7, 13, and 14 depend upon claim 1, and are therefore not anticipated by Ehreth for at least the reasons identified above with respect to claim 1.

With respect to claim 18, Ehreth does not disclose or suggest, for example, "a network interface module for receiving signals, including video signals, from a

telecommunications network, wherein the received video signals correspond to the channel select commands” and “a video processor that processes the video signals to produce at least one television signal,” as recited in claim 18. Ehreth discloses a network interface module 32 that receives video signals regardless of the channel select commands and a modulating unit 34 that selects the video signal and modulates the selected video signal to produce a video signal having a desired frequency. Ehreth notes (col. 3, lines 15-18) that the “[b]roadband/narrowband network may provide . . . only those signals requested by communication controller 30,” which, according to the Examiner, corresponds to the residential gateway as recited in claim 1 of the present application. However, Ehreth does not teach or suggest that video signals are received by a residential gateway in response to a channel select command, as claimed. Thus, Ehreth does not disclose or suggest the residential gateway as recited in claim 18.

Claims 20-24 and 31 depend upon claim 18, and are therefore not anticipated by Ehreth for at least the reasons discussed above with respect to claim 18.

With respect to claim 35, Ehreth does not disclose or suggest “transmitting the at least one channel select command to [a] telecommunications network,” “processing [a] video signal into at least one television signal corresponding to the at least one channel select command, the processing being performed by a video processor,” and “transmitting the at least one television signal to the appropriate television,” all as recited in claim 35. Ehreth does not disclose or suggest transmitting a channel select command upstream to the telecommunications network. Moreover, as discussed above with respect to claim 1, Ehreth discloses producing the at least one television signal within communication controller 30 and transmitting that signal to channel selection and signaling unit 50. The channel selection and signaling unit 50 (which corresponds to the claimed receiving unit) then transmits that signal to a television 100.

Claims 37-43 depend upon claim 35, and are therefore not anticipated by Ehreth for at least the reasons discussed above with respect to claim 35.

Claim 45-47 are allowable for at least the reasons discussed above with respect to claims 1, 18, and 35. Specifically, with respect to claim 45 and as discussed above with respect to claim 35, Ehreth does not disclose or suggest "transmitting the channel select commands to the telecommunications network," as recited in claim 45. With respect to claims 46 and 47 and as discussed above with respect to claim 35, Ehreth does not disclose "a network interface module for transmitting upstream signals, including channel select commands, to the telecommunications network," as recited in both claims 46 and 47. In addition, Ehreth does not disclose or suggest that a wireless remote control transmits channel select commands to remote antennae packages connected to a television. Ehreth does not teach or suggest that the channel selection and signaling units can be remote antennae packages.

Accordingly, it is respectfully submitted that claims 1, 3-7, 13-14, 18, 20-24, 31, 35, 37-43, and 45-47 are allowable.

The Examiner has also rejected claims 5, 7, 11-17, 22, 29-30, 32-34, 47-49, 50-53, and 55-57 as being anticipated by U.S. Patent No. 6,418,149 to Swisher et al. The Applicants respectfully disagree with these rejections and request the Examiner to reconsider them.

With respect to claims 5, 7, 11-17, 22, 29-30, and 32-34, these claims depend upon independent claims that are allowable over Swisher et al. (and, as discussed above, are allowable over the other prior art of record). The rejection of dependent claims is improper when the underlying independent claims are allowable. In other words, a prior art rejection

under 35 U.S.C. § 102 is improper if claims from which the rejected claims depend are not included in the rejection.

With respect to independent claims 47, 50, and 57, each of these claims include elements of the residential gateway that were disclosed in the Eames et al. application (now Patent No. 6,317,884) ("Eames '884") to which the instant application claims priority. These aspects of the residential gateway were discussed as background in Swisher et al., which then discloses and claims a method and apparatus for using customer premises wiring to transmit signals to and from a residential gateway system, for example as disclosed in Eames '884. *See* Col. 1, lines 55-59 of Swisher, which discloses the Eames '884 application as background. Thus, the subject matter disclosed in Swisher et al. that refers to the residential gateway was invented by Eames and Eldering, and disclosed in Eames '884, to which a claim of priority has been made in the present application. By relying on this disclosure in Swisher et al., the Examiner cites Applicants Eames and Eldering's own invention against the present application, which Applicants believe to be improper. Thus, the rejections of claims 47, 50, and 57 under Swisher et al. are improper because the subject matter disclosed in Swisher et al. was invented by Applicants Eames and Eldering, as demonstrated by the disclosure of issued patent Eames '884. Claims 48-49 depend upon claim 47, and claims 51-53 and 55-56 depend upon claim 50, making these claims allowable for at least the reasons discussed above with respect to claims 47 and 50 respectively.

Accordingly, it is respectfully submitted that claims 5, 7, 11-17, 22, 29-30, 32-34, 47-49, 50-53, and 55-57 are allowable.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 2, 19, and 32-34 under 35 U.S.C. § 103 as being obvious over Ehreth in view of U.S. Patent No. 5,574,964 to Hamlin ("Hamlin"). The Applicants respectfully disagree with these rejections and request the Examiner to reconsider them. Claims 2 depends upon claim 1, while claims 19 and 32-34 depend upon claim 18, each of which is allowable as discussed above. Hamlin does not provide any teachings or suggestions that overcome the deficiencies of Ehreth as discussed above. Accordingly, as neither Ehreth nor Hamlin teaches or suggests these features of independent claims 1 and 18, the combination of Ehreth and Hamlin also fails to teach or suggest the limitations of those claims. Moreover, there is no motivation or suggestion to combine Ehreth and Hamlin. For example, while Ehreth discloses a remote controller associated with each one or group of television receivers in a system, Hamlin discloses and suggests a single remote controller for all of the receiving units in the system.

Accordingly, it is respectfully submitted that claims 2, 19, and 32-34 are allowable.

The Examiner also rejected claims 8-12, 25-30, 36, and 44 under 35 U.S.C. § 103 as being obvious over Ehreth. The Applicants respectfully disagree with these rejections and request the Examiner to reconsider them. Claims 8-12 depend upon claim 1, claims 25-30 depend upon claim 18, and claims 36 and 44 depend upon claim 35. As discussed above, claims 1, 18, and 35 are allowable. Accordingly, it is respectfully submitted that dependent claims 8-12, 25-30, 36, and 44 are also allowable.

Miscellaneous Matters

In the Office Action dated July 18, 2003, the Examiner indicated that claims 54 and 58 contain allowable subject matter and would be allowable if rewritten in independent form. While Applicants believe these claims are allowable because they depend upon base claims that are allowable, claims 54 and 58 have been rewritten in independent form in order to expedite prosecution.

In the Office Action dated July 18, 2003, the Examiner suggested that Applicants' failure to address instances in which the Examiner took Official Notice amounted to an admission of fact. However, Applicants did not address these arguments because the claims in question were allowable for other reasons. Because Applicants demonstrate herein that all pending claims are allowable, they do not address nor do they concede the Examiner's arguments relating to Official Notice or that the matters of which the Examiner took Official Notice have been admitted.

* * *

Applicants submit that, by this Amendment and as explained in this Response, all outstanding rejections have been overcome. Pending claims 1-58 therefore are all allowable, placing the application in condition for allowance.

If the undersigned can be of any assistance in advancing prosecution, please call him at (202) 662-5468.

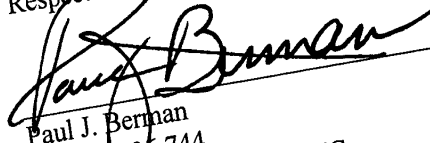
It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this

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application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-0740, under Docket No. 025684.114-US. A duplicate copy of this paper is enclosed.

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Respectfully submitted,



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